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520.43566X00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): ISHIBASHI, et al.

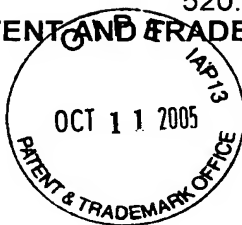
Serial No.: 10/789,979

Filed: March 2, 2004

For: ACTUATOR FILM MATERIAL, ACTUATOR FILM AND ACTUATOR  
USING THE SAME

Examiner: Addison, Karen

Art Unit: 2834



RESPONSE

October 11, 2005

Commissioner for Patents (No Fee)  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The following remarks are respectfully submitted in connection with the above-identified application in response to the Office Action dated September 9, 2005.

The requirement for restriction to one the of the inventions identified by the Examiner as Group I-claims 1-6, drawn to a polymer material for an actuator film classified in class 252, subclass 62.9 and Group II-claims 7-13 drawn to a piezoelectric electric transducer structure classified in class 310, subclass 800, is traversed, as being a mischaracterization of the claimed subject matter, as well as being improper in terms of whether a restriction between inventions or an election among species is being required.

Turning first to the mischaracterization of Group II as being drawn to a "piezoelectric" transducer structure, Applicants note that claims 7-11 do not utilize the term "piezoelectric" and the materials of the actuator, as claimed, are not ferroelectric substances which have piezoelectric properties, but rather are electric conductive organic substances such that Group II may be properly characterized as

an electroactive polymer transducer structure.

With regard to the requirement for restriction, such is not understood in relation to the Examiner's indication "Inventions group I and group II are related as mutually exclusive species in an intermediate-final product relationship" (emphasis added) with the Examiner referring to patentably distinct species in MPEP §806.04(h). Applicants note that different criteria are utilized for election of species and restriction. Thus, Applicants contend that the requirement, as set forth, appears to be improper and should be withdrawn.

Applicants note that claim 7 of Group II recites the feature of an actuator comprising an actuator film having the features as recited in claim 1 of Group I, and therefore, Applicants submit that the recited features of claim 1 of Group I are essentially incorporated into the recited features of claim 7 of Group II such that patentable distinctness with respect to such features is not apparent. In fact, in order to properly examine the features of claim 7, Applicants submit that it would be necessary to search in class 252, subclass 62.9, which the Examiner indicates is the proper search area for Group I drawn to a polymer for an actuator film, which features are recited in Group II. Thus, since the features of claims Group I are coextensive with the features Group II, with Group II reciting additional structural features, Applicants submit that the search requirements for Group II are coextensive with the search requirements for Group I such that an overlapping search is necessitated. Accordingly, Applicants contend that the Examiner has failed to show distinctness under whatever criteria is appropriate and the requirement for restriction should be withdrawn.

In order to provide a complete response to the Restriction Requirement, Applicants provisionally elect, with traverse, Group II including claims 7-13.

For the foregoing reasons, withdrawal of the Restriction Requirement and favorable action with respect to all claims present in this application are requested.

To the extent necessary, applicant's petition for an extension of time under 37

CFR 1.136. Please charge any shortages in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (520.43566X00) and please credit any excess fees to such deposit account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Melvin Kraus", written over a horizontal line.

Melvin Kraus  
Registration No. 22,466  
ANTONELLI, TERRY, STOUT & KRAUS, LLP

MK/at  
Attachment(s)  
(703) 312-6600